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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* KIM HYONSU and YOSHIROH KAMIYAMA

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Appeal 2017-007979  
Application 13/568,630  
Technology Center 2100

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Before ELENi MANTIS MERCADER, JAMES R. HUGHES, and  
CATHERINE SHIANG, *Administrative Patent Judges*.

SHIANG, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 13–27, which are all the claims pending and rejected in the application. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

*Introduction*

According to the Specification, the present invention relates to client-server interactions. *See generally* Spec. ¶¶ 5–10, 16–26. Claim 13 is exemplary:

13. A method, performed within and by a translation server, comprising:

receiving, from a client, a translation request to translate an original document;

transmitting a partial portion of the original document or the complete original document to a translation engine;

extracting image data from the original document;

returning, after extracting the image data and before receiving translation data from the translation engine, an incomplete portion of a results document to the client; and

returning, after receiving the translation data from the translation engine, a remaining portion of the results document to the client.

### *References and Rejections*

Claims 23–27 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Claims 13–27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Flanagan (US 6,993,471 b1, issued Jan. 31, 2006) and Netscape (Roland Elgey, *Two solutions to potential problems*, Library of Congress, Catalog No. 95-67809, 3 USING NESTCAPE 50–51 (1995)).

### ANALYSIS

We disagree with Appellants' arguments, and agree with and adopt the Examiner's findings and conclusions in (i) the action from which this

appeal is taken and (ii) the Answer to the extent they are consistent with our analysis below.<sup>1</sup>

On this record, the Examiner did not err in rejecting claim 13.

35 U.S.C. § 101

Appellants argue:

As stated by the Board in footnote 5 of *Ex parte Mewherter*, “before 2002 there is little evidence that the ordinary and customary meaning of such ‘storage medium’ terms encompassed a signal.” The present application claims priority to February 28, 2002, and the Examiner has not presented any extrinsic evidence to support a finding that the ordinary and customary meaning of the claimed “computer usable storage medium” encompasses a transitory, propagating signal *per se*.

Appeal Br. 8; *see also* Appeal Br 8–9; Reply Br 2.

Independent claim 23 recites “a computer usable storage medium,” and Appellants do not contend the Specification has assigned a special meaning to that term.<sup>2</sup>

Appellants do not contend *Ex parte Mewherter*, Appeal No. 2012-007692 (PTAB May 08, 2013) (precedential-in-part) is non-precedential *in or after* 2002 with respect to the 101 issue. Instead, Appellants contend footnote 5 of *Mewherter* states “before 2002 there is little evidence that the ordinary and customary meaning of such ‘storage medium’ terms encompassed a signal.” Appeal Br. 8. However, that footnote discusses the

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<sup>1</sup> To the extent Appellants advance new arguments in the Reply Brief without showing good cause, Appellants have waived such arguments. *See* 37 C.F.R. § 41.41(b)(2).

<sup>2</sup> Appellants’ assertion that the Specification’s paragraph 63 does not expand the term’s definition to include a signal (Appeal Br. 8–9) does not show *Mewherter* is inapplicable here.

meaning of “storage medium” *before* 2002, but Appellants acknowledge the priority date of this invention is February 28, 2002 (Appeal Br. 8)—*not before* 2002. Therefore, Appellants have not shown the footnote is applicable here. Nor have Appellants shown the holding of *Mewherter*, which the Examiner applies to claims 23–27, is inapplicable here.

Because Appellants have not persuaded us the Examiner erred, we sustain the Examiner’s rejection of claims 23–27 under 35 U.S.C. § 101.

We note Appellants are not precluded from amending the claims to overcome the rejection. Relevant guidance is in the U.S. Patent & Trademark Office, *Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010) (“A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation ‘non-transitory’ to the claim.”); U.S. Patent & Trademark Office, *Evaluating Subject Matter Eligibility Under 35 USC § 101* (August 2012 Update) (pp. 11–14), available at [http://www.uspto.gov/patents/law/exam/101\\_training\\_aug2012.pdf](http://www.uspto.gov/patents/law/exam/101_training_aug2012.pdf) (noting that while “non-transitory” is a viable option for overcoming the presumption the media encompass signals or carrier waves, merely indicating such media are “physical” or “tangible” will not overcome such presumption). *See id.* at 14.

## Obviousness

### I

Appellants contend Netscape does not teach a “*translation server*,” “*translation request*,” “*translation engine*,” “*translation data*,” “before

receiving *translation* data,” and “after receiving the *translation* data,” because Netscape does not teach the claim element “translation.” *See* Appeal Br. 9–18 (emphases added); Reply Br. 2–10. Appellants further argue Netscape does not teach the claimed “extracting image data” and “after extracting image data,” because Netscape does not teach removing (extracting) image data. *See* Appeal Br. 13–14, 17; Reply Br. 8. Appellants also contend in Netscape, the cited operations are performed within the client, not “a translation server.” *See* Appeal Br. 9, 17; Reply Br. 5.

Appellants have not persuaded us of error. Because the Examiner relies on the combination of Flanagan and Netscape to teach the disputed claim limitations, Appellants cannot establish nonobviousness by attacking Netscape individually. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). The Examiner finds—and Appellants do not dispute—Flanagan teaches the claimed “by a translation server,” “translation request,” “translation engine,” and “extracting image data.” *See* Final Act. 4. Therefore, Flanagan teaches the recited “translation.” As a result, Netscape does not need to separately teach those terms.

Further, the Examiner finds—and Appellants do not dispute—Netscape teaches “before receiving . . . data” and “after receiving the . . . data.” *See* Final Act. 5. Therefore, Flanagan and Netscape collectively teach “before receiving translation data” and “after receiving the translation data.”

In addition, the Examiner finds—and Appellants do not dispute—Netscape teaches “after . . .” (Final Act. 5). As discussed above, Flanagan teaches the claimed “extracting image data.” Therefore, Flanagan and Netscape collectively teach “after extracting image data.”

Appellants' contention that Netscape teaches the operations are performed within the client, not "a translation server," does not show Examiner error. As discussed above, because Flanagan teaches "by a translation server," Netscape does not need to separately teach that feature. Even if Netscape teaches the operations are performed within the client as Appellants assert, Flanagan and Netscape collectively teach performing the cited steps "by a translation server."<sup>3</sup>

## II

Appellants contend the Examiner has not shown Flanagan and Netscape are analogous art. *See* Appeal Br. 11–13; Reply Br 6–7.

"Two *separate* tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed ['Field Test'] and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved ['Problem Test']." *In re Klein*, 647 F.3d 1343, 1348 (Fed. Cir. 2011) (emphases added). "Whether a reference in the prior art is 'analogous' is a fact question." *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992).

To determine this invention's field of endeavor, we consider the "explanations of the invention's subject matter in the patent application,

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<sup>3</sup> Appellants' argument (Appeal Br. 16) about the Examiner's obviousness determination regarding performing functions in a server instead of a client is not directed to the Examiner's mapping in the Final Office Action. As discussed above, the Examiner rejection in the Final Office Action modified Flanagan's method to incorporate some steps taught by Netscape, and Flanagan's server—not a client—performs those steps in the resulting combination.

including the embodiments, function, and structure of the claimed invention.” *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004).

Appellants acknowledge “the Examiner asserts that ‘Flanagan and Netscape’s teachings are in the same field’” and “the Examiner can establish that Using Netscape, Flanagan, and the claimed invention all involve some type of client-server interactions” (Reply Br. 7). As a result, Appellants have not shown Examiner error because they acknowledge the Examiner finds this invention, Flanagan, and Netscape are all in the same field of client-server interactions. Appellants’ assertion that “client-server interactions characterizes a large portion of what occurs in the internet, and such a characterization of the ‘field of endeavor’ is overly broad” (Reply Br. 7) is conclusory, and Appellants fail to show that conclusion is correct. In particular, Appellants fail to apply the necessary analysis under the case law (above) to support their conclusion.

Because Appellants have not persuaded us the Examiner erred, we sustain the Examiner’s rejection of independent claim 13, and independent claims 18 and 23 for similar reasons.

We also sustain the Examiner’s rejection of corresponding dependent claims 14–17, 19–22, and 24–27, as Appellants do not advance separate substantive arguments about those claims.

#### DECISION

We affirm the Examiner’s decision rejecting claims 13–27.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED